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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/663,320	09/15/2000	Gavin C. Hirst	BBI-6081CP	3710

7590 09/26/2002

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[REDACTED] EXAMINER

KIFLE, BRUCK

ART UNIT	PAPER NUMBER
1624	21

DATE MAILED: 09/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/663,320

Applicant(s)

Hirst et al.

Examiner
Bruck Kifle, Ph.D.

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1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on Sep 9, 2002
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.
- 4) Claim(s) 1-88 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-88 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) Other: _____

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Applicant's amendments and remarks filed 9/9/2002 have been received and reviewed.

Claims 1-88 are now pending in this application.

Claim Rejections - 35 USC § 112

Claims 1-88 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

i) Regarding the “prodrugs or the biologically active metabolites”, Applicants argue that this is the same as “pharmaceutically acceptable salts thereof.” However, this is not the same because salts do not alter the compound whereas prodrugs are entirely different compounds. One skilled in the art can easily say whether it is a compound or a salt thereof, whereas, one skilled in the art cannot say whether a given derivative is a prodrug or not. The metes and bounds of a prodrug are not known. One cannot say what it looks like. Arriving at a prodrug of a given drug is a research effort. Should Applicants know what these prodrugs look like, then this should be disclosed.

ii) In support of the term “substituted”, Applicants point to page 55, lines 11 to 24 of the specification. However, these line do not provide the “clear and definite definition” that Applicants say is provided. Should only these groups be contemplated, then these should be included into the claims. One skilled in the art cannot say which substituent is intended and which one is not. Are, for example, dimers of the instant compound intended? How about sugars, antibodies, nucleotides, arsenic, etc? The term is indefinite without any support in the specification. Which substituent is not intended?

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iv) Regarding the term “heterocyclic”, Applicants point to page 54, lines 8-25 of the specification. The claims need to say how many atoms make up the ring, which atoms are present and what kind of a ring (monocyclic, bicyclic, spiro, fused, bridged, saturated, etc.) is intended. The specification points to mere examples.

Applicants are reminded that although the claims are interpreted in light of the specification, critical limitations from the specification cannot be read into the claims (see, e.g., *In re Van Guens*, 988 F.2d 1181, 26 PSPG2d 1057 (Ded. Cir. 1991)). Accordingly, without the recitation of all these critical limitations, the claims do not adequately define the instant invention.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Altmann et al. (WO 97/49706). The reference teaches a generic group of substituted 7-amino-pyrrolo[3,2-d]pyrimidine derivatives which embraces applicants' claimed compounds. The basis of this rejection is the same as given in the previous office action and is incorporated herein fully by reference. Applicants argue that the reference does not suggest Applicants R₂ group which is defined as -Z¹⁰¹-Z¹⁰². However, the reference clearly suggests this group (see page 1, definition of R₃. The complexity of instant R₂ that Applicants point to is not seen because it can in fact be reduced to hydrogen. Applicants further argue that the reference does not suggest the full scope

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of claim 1. This argument has no basis because a claim is not rejected or allowed in part but as a whole.

It has been held that a prior art disclosed genus of useful compounds is sufficient to render prima facie obvious a species falling within a genus. *In re Susi*, 440 F.2d 442, 169 USPQ 423, 425 (CCPA 1971), followed by the Federal Circuit in *Merck & Co. v. Biocraft Laboratories*, 847 F.2d 804, 10 USPQ 2d 1843, 1846 (Fed. Cir. 1989).

Information Disclosure Statement

The information disclosure statement filed 4/25/01 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR

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1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle whose telephone number is (703) 305-4484.

The fax phone number for this Group is (703) 308-4556 or (703) 305-3592. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

September 25, 2002


Bruck Kifle
Primary Examiner
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